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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/868,889	09/14/2001	Jon Hangeland	102241-101	6789
7590	11/17/2004		EXAMINER COPPINS, JANET L	
Wiggin & Dana Intellectual Property Law Section One Century Tower New Haven, CT 06508-1832			ART UNIT 1626	PAPER NUMBER

DATE MAILED: 11/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/868,889

Applicant(s)

HANGELAND ET AL.

Examiner

Janet L. Coppins

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 August 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14, 17-22, 27 and 29 is/are pending in the application.
- 4a) Of the above claim(s) 1, 13, and 18, (in part) is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 5-14, 17, 19, 22, 27 and 29 is/are rejected.
- 7) ☒ Claim(s) 3 and 4 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claims 1-14, 17-22, 27, and 29 are pending in the instant application.

Response to Amendment

1. Receipt is acknowledged of Applicants' Amendment and Response, filed August 16, 2004, which has been reviewed by the Examiner and entered of record in the file. Accordingly, claims 23, 24, and 28 have been cancelled and claims 2 and 29 have been amended.

Election/Restrictions

2. This application contains subject matter drawn to inventions non-elected with traverse, i.e. Groups I-III, drawn to compounds and compositions wherein R₄ is other than a carboxylic acid amide (CONR'R"), in the response of February 10, 2003. Claims 1 in part, 13 (wherein R₄ is heteroaromatic hydrocarbon or acylsulphonamide), and 18 (i.e. the fifth compound from the top), each contain subject matter that has been withdrawn from consideration by the Examiner. A complete reply to the final rejection must include cancellation of non-elected subject matter or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

Claim Rejections - 35 USC § 112

3. Claims 23 and 29 previously rejected under 35 USC 112, first paragraph. In view of Applicants' cancellations and amendatory changes to the claims, the Examiner withdraws the rejections.

Claim Rejections - 35 USC § 101

4. Claim 23 previously rejected under 35 USC 101 as being a reach-through claim. Applicants have cancelled claim 23, rendering the rejection moot, therefore the Examiner withdraws the 35 USC 101 rejection.

Claim Rejections - 35 USC § 102 and 35 USC § 103

5. Claims 1, 2, 5-14, 19-22, and 27-29 previously rejected under 35 USC 102(e) as being anticipated by Ryono et al, U.S. Pat. No. 6,395,784. Applicants argue that the Ryono reference is not a proper reference since the instant application has earlier foreign priority. Accordingly, the Examiner withdraws the 35 USC 102(e) and 35 USC 103(a) rejections to the claims.

6. However, the Examiner maintains the 35 USC 102(f) rejections to claims 1, 2, 5-14, 19-22 and 27-29. As stated previously, the subject matter of the instant invention, thyroid receptor ligands according to the formula of claim 1, was previously claimed in U.S. Pat. No. 6,395,784. The 6,395,784 patent lists Denis E. Ryono of Princeton, NJ as a sole inventor, who is also listed as one of the inventors in the instant application. The question of inventorship, Ryono alone or the instant inventive entity, must be resolved.

Double Patenting

7. Claims 1, 2, 5-14, 19-22 and 27-29 stand rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over U.S. 6,395,784. Applicants have traversed the rejection, arguing that the instant claims are not obvious over the thyroid receptor ligands of Ryono et al, since, "Ryono does not disclose or suggest an alkyl ... as substituents on the carboxylic acid amide moiety" (pages 20-21 of Applicants' Remarks) and therefore the pending rejection is improper.

8. The Examiner respectfully disagrees, and directs the Applicants' attention to the Ryono patent, in the table in column 20, Examples 25 and 26, which teaches methyl as a substituent on the carboxylic acid moiety, therefore Ryono does in fact disclose alkyl as a substituent on the carboxylic acid moiety. Furthermore, several of the individual species recited in instant claim 18

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are taught in the above-mentioned table of Ryono et al, please refer, for example, to the compound "N-[3,5-Dibromo-4-(4-hydroxy-3-isopropylphenoxy)benzoyl]glycine" which is the twelfth compound listed from the top of claim 18, and is also covered by Ryono et al in the table mentioned above, Example 8.

As stated in the previous Office Action, the instant claimed compounds would have been obvious because one skilled in the art would have been motivated to prepare the compounds taught in the reference with the expectation of obtaining compounds which could be used for treating the same diseases associated with metabolism dysfunction or dependent on the expression of a T3 regulated gene. It would have been prima facie obvious to employ the formula claim 1 of the '784 patent, particularly when Applicants' elected Group IV, carboxylic acid amides, are taught as preferred compounds and specifically claimed in the reference patent. Therefore, the instant claimed compounds would have been suggested to one skilled in the art, and the Examiner maintains the obviousness-type double patenting rejection over claims 1-10, 13-18, 21 and 22 of Ryono et al.

Claim Objections

9. Claims 3 and 4 remain rejected as dependent upon rejected base claims.

Conclusion

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after

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the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


Telephone Inquiry

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Janet L. Coppins whose telephone number is 571.272.0680. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph K. McKane can be reached on 571.272.0699. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Janet L. Coppins
November 12, 2004


CEILA CHANG
PRIMARY EXAMINER
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